

REMARKS/ARGUMENTS

Claims 18, 19, and 21-65 are pending in this application. Claims 23, 26-30, and 51-65 are withdrawn. Claims 18, 19, 21, 22, 24, 25, 31-50 stand rejected. By this response, claim 32 is cancelled. Claims 18, 33, 38, 39, 43, 49, and 50 are amended.

Obviousness-Type Double Patenting Rejections

The Office Action provisionally rejected claims 18, 19, 21, 22, 24, 24, and 31-50 on the grounds of obviousness-type double patenting as unpatentable over the following claims:

- 1, 19, and 25 of copending Application No. 10/971,577 (filed October 22, 2004 and claiming priority to provisional applications filed on October 24 and 27, 2003)
- 1-21, 23, and 24 of copending Application No. 10/971,549 (filed October 22, 2004 and claiming priority to provisional applications filed on October 24 and 27, 2003)
- 1-24 of copending Application No. 10/972,298 (filed October 22, 2004 and claiming priority to provisional applications filed on October 24 and 27, 2003)

The instant Application was filed on April 9, 2004 and claims priority to German Application No. 103 16 177.5-54, filed on April 10, 2003. The cited copending applications are not prior art to the instant Application because the instant Application has an earlier priority date than the cited copending applications. Therefore, the obviousness-type double patenting rejections are improper, and the Applicant respectfully requests the withdrawal of these rejections.

35 U.S.C. § 112 Rejections

The Office Action rejected claims 32-38 under 35 U.S.C. § 112, second paragraph, as indefinite. By this response, claim 32 is cancelled and claim 18 is amended to incorporate the features of claim 32. Claims 33 and 38 are amended to depend from claim 18 instead of claim 32. The Applicant respectfully requests the allowance of claims 33-38.

35 U.S.C. §§ 102 and 103 Rejections

The Office Action rejected claims 18, 22, 32, 33, 35, 36, 43, 44, 46, 47, and 50 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,009,229 to Grandjean et al.

Amended claim 18 recites an apparatus for inserting an electrode into a myocardium of the heart. The apparatus comprises “an anchor configured to advance through myocardial tissue in a first orientation and to anchor against an epicardial surface in a second orientation,” “a tension element having a proximal end and a distal end attached to the anchor,” and “an electrode having an inner guide channel to accommodate the tension element and having a pole at an end adapted for stimulating the myocardium.” The “electrode and the tension element are configured such that the electrode can be threaded over the proximal end of the tension element and slideably advanced over the tension element towards the anchor during implantation.”

Grandjean discloses a preformed helix 122 which is deformably molded into strand 120 to aid in attachment. (3:44-45.) The helix 122 is not configured to advance through myocardial tissue in a first orientation and anchor against an epicardial surface in a second orientation. Instead, the helix 122 shares a longitudinal axis with the strand 120 throughout implantation. Further, the helix 122 is not configured to anchor against an epicardial surface. The helix 122 is configured to embed in the myocardium (4:7-9, FIG. 6). Because the helix 122 is deformable, it cannot anchor against an epicardial surface. Tension applied to the strand 120 would cause the helix 122 to unwind and withdraw from an epicardial surface into the myocardium.

Grandjean also fails to disclose an electrode and tension element configured such that the electrode can be threaded over the proximal end of the tension element and slideably advanced over the tension element towards the anchor during implantation. The Applicant notes that the instant specification identifies the electrode 2 as including a pole 2a and running from the heart pacemaker 4 to the heart (paragraph [0032], FIG. 1). The structure in Grandjean comparable to the claimed electrode is the lead 100, not the electrode 114. The lead 100 and strand 120 in Grandjean are not configured such that the lead 120 can be

threaded over the strand 120 and advanced toward the helix 122 during implantation because the strand 120 is mechanically attached to the proximal end of the lead. (3:32-34.)

Claim 18 is allowable over Grandjean because Grandjean neither teaches nor suggests an apparatus for inserting an electrode into the myocardium having the features recited in claim 18. Claims 22, 33, 35, and 36 depend from claim 18 and are patentable for at least the reasons presented with respect to claim 18. The Applicant respectfully requests the allowance of claims 18, 22, 33, 35, and 36.

Amended claim 43 recites “an anchor configured to anchor against an epicardial surface.” Amended claim 50 recites means for anchoring “configured to anchor against an epicardial surface.” Claims 43 and 50 both recite “a tension element having a proximal end and a distal end,” and an “electrode having an inner guide channel” wherein the tension element and electrode are configured such that the electrode “can be threaded over the proximal end of the tension element and slideably advanced over the tension element” during implantation. As discussed with respect to claim 18, Grandjean neither teaches nor suggests an anchor or anchor means configured to anchor against an epicardial surface or a tension element and electrode configured such that the electrode can be threaded over the proximal end of the tension element and slideably advanced over the tension element during implantation.

Because Grandjean neither teaches nor suggests an apparatus having the features recited in claims 43 and 50, these claims are patentable over Grandjean. Claims 44, 46, and 47 depend from claim 43, and are patentable for at least the reasons presented with respect to claim 43. The Applicant respectfully requests the allowance of claims 43, 44, 46, 47, and 50.

The Office Action rejected claims 38 and 48 under 35 U.S.C. § 103(a) over Grandjean in view of Official Notice. Claims 39, 40, and 49 were rejected over Grandjean in view of Wesbey. These references do not remedy the deficiencies of Grandjean. Claims 38, 39, and 40 depend from claim 18 and are patentable for at least the reasons presented with respect to claim 18. Claims 48 and 49 depend from claim 43 and are patentable for at least the reasons presented with respect to claims 43. The Applicant respectfully requests the allowance of claims 38, 39, 40, 48, and 49.

In conclusion, the Applicant respectfully requests the allowance of all pending claims in this application. The Applicant invites the Examiner to contact the undersigned at the number listed below with any remaining questions.

Respectfully submitted,

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